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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/611,863	07/03/2003	Ulrich Muller	239953US0X	3849

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EXAMINER

KEYS, ROSALYND ANN

ART UNIT PAPER NUMBER

1621

DATE MAILED: 06/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/611,863

Applicant(s)

MULLER ET AL.

Examiner

Rosalynd Keys

Art Unit

1621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 June 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) 9 and 10 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-10 are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>10/1/03</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status of Claims

1. Claims 1-10 are pending.

Claims 1-8 are rejected.

Claims 9 and 10 are withdrawn from consideration.

Election/Restrictions

2. Applicant's election with traverse of Group I, claims 1-7 and 8 in the reply filed on June 14, 2004 is acknowledged. The traversal is on the ground(s) that The Examiner states that the product is not allowable but has provided no information with regard to the determination of patentability of the product. Therefore, the Examiner's reasoning is nearly a restatement of the Examiner's conclusion that the two groups are patentably distinct. As the Examiner has provided insufficient reasons in support of this belief, the Examiner has not met the burden placed upon her, and accordingly, the restriction is believed to be improper and should be withdrawn. This is not found persuasive because polyoxyalkylene alcohols are well known compounds as is shown in the rejections that appear below. Thus, since the product is not allowable, restriction is proper between said method of making and method of using.

The requirement is still deemed proper and is therefore made FINAL.

3. Claims 9 and 10 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on June 14, 2004.

Information Disclosure Statement

4. The information disclosure statement filed October 1, 2003 has been considered.

Specification

5. The incorporation of essential material in the specification by reference to a foreign application or patent, or to a publication is improper. Applicant is required to amend the disclosure to include the material incorporated by reference. The amendment must be accompanied by an affidavit or declaration executed by the applicant, or a practitioner representing the applicant, stating that the amendatory material consists of the same material incorporated by reference in the referencing application. See *In re Hawkins*, 486 F.2d 569, 179 USPQ 157 (CCPA 1973); *In re Hawkins*, 486 F.2d 579, 179 USPQ 163 (CCPA 1973); and *In re Hawkins*, 486 F.2d 577, 179 USPQ 167 (CCPA 1973). See also MPEP 608.01(p).
6. The disclosure is objected to because of the following informalities: the specification contains typos such as the misspelling of the word skeleton on page 2, line 17.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

Art Unit: 1621

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

8. Claims 1-8 are rejected under 35 U.S.C. 102(a) as being anticipated by Muller et al. (US 2003/0078311 A1).

Muller discloses the instant method of preparing a polyoxyalkylene alcohol et al. (see entire disclosure, in particular paragraphs 0006 to 0069).

9. Claims 1-5 are rejected under 35 U.S.C. 102(a) as being anticipated by Mueller et al. (DE 1011230, which is equivalent to US 2004/0097724 A1)).

Muller et al. teach the claimed invention (see abstract provided by Applicants in their IDS or paragraphs 0006 to 0013, paragraphs 0025 to 0030 and paragraph 0043 of US 2004/0097724 A1).

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claim 8 is rejected under 35 U.S.C. 102(b) as being anticipated by Hamilton (US 3,328,467).

Hamilton disclose polyoxyalkylene alcohols which are prepared by an alkoxylation reaction involving the reaction of an alkylene oxide with a compound having an active hydrogen atom in the presence of a catalyst (see entire disclosure, in particular column 1, lines 8-12 and the examples). Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ

Art Unit: 1621

964, 966 (Fed. Cir. 1985). The instant polyoxyalkylene alcohols do not appear to be different from those disclosed by Hamilton, except for the method of producing them.

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

13. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

14. Claims 1 and 6-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mueller et al. (DE 1011230, which is equivalent to US 2004/0097724 A1) in view of Hamilton (US 3,328,467).

Mueller et al. disclose the invention as described above, but discloses That the catalyst is useful in an alkoxylation reaction , however Mueller et al. fail to and disclose the alkoxylation steps .

Hamilton teaches alkoxylation reactions involving the reaction of an alkylene oxide with a compound having an active hydrogen atom in the presence of a catalyst (see entire disclosure, in particular column 1, lines 8-12). The alkylene oxide disclosed as suitable include ethylene oxide, propylene oxide and butylene oxides (see column 1, line 58 to column 2, line 8).

One having ordinary skill in the art at the time the invention was made would have reasonably concluded that Mueller et al. understood alkoxylation to mean a reaction between an alkylene oxide with a compound having an active hydrogen atom, as taught by Hamilton, especially since the disclosure of Hamilton was available about 35 years prior to the invention by Mueller et al.

15. Claims 1-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hamilton (US 3,328,467) in view of Yaghi (US 5,648,508).

Hamilton teaches alkoxylation reactions involving the reaction of an alkylene oxide with a compound having an active hydrogen atom in the presence of a catalyst (see entire disclosure, in particular column 1, lines 8-12). The alkylene oxides disclosed as suitable include ethylene oxide, propylene oxide and butylene oxides (see column 1, line 58 to column 2, line 8).

Hamilton differs from the instant invention in that they use aluminosilicates, such as zeolites A, X and Y (see column 3, lines 13-23), whereas the instant invention uses a catalyst comprising a metalloorganic framework material of metal ions and at least bidentate coordinately bound organic ligands.

Yaghi teaches a metalloorganic framework material of metal ions and at least bidentate coordinately bound organic ligands, which are useful as a substitute for zeolite catalysts (see entire disclosure, in particular column 1, lines 24-55; column 3, lines 38-63).

One having ordinary skill in the art at the time the invention was made would have found it obvious to substitute the catalysts of Yaghi for the zeolite catalyst of Hamilton, since Yaghi teaches that use of his catalyst would allow one to prepare microporous materials which have controlled pore distributions and sizes, which was lacking in zeolites.

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rosalynd Keys whose telephone number is 571-272-0639. The examiner can normally be reached on M, R and F 3:30-8:30 pm and T-W 5:30-10:30 am.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann Richter can be reached on 571-272-0646. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 1621

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Rosalyn Keys
Primary Examiner
Art Unit 1621

June 25, 2004